

REMARKS

Applicant has studied the Final Office Action of January 20, 2004 and offers the following remarks in response thereto. Applicant appreciates the telephonic interview of March 18, 2004 when some of the issues below were discussed. Where appropriate, the comments from the telephonic interview are incorporated and addressed below.

Applicant appreciates the withdrawal of the § 112 rejection to the claims at this time and the acceptance of the proposed drawing correction.

Claims 2-25, 19-22, 24 and 26-28 were rejected under 35 U.S.C. § 103 as being unpatentable over Jorgensen. Applicant respectfully traverses.

As noted in the previous response, Jorgensen has a filing date after the filing date of the present application. Specifically, Jorgensen is filed over three months after the present application. Jorgensen does, however, claim the benefit of an earlier filed provisional application, which was filed in July 1998, prior to Applicant's filing date.

In the prior response, Applicant argued that Jorgensen only predates Applicant's filing date if the subject matter on which the Patent Office relies is present in the provisional application. Applicant further argued that it is the Patent Office's obligation to provide the provisional application to prove that the provisional application provides such support. The Patent Office responds in the present Office Action with an unsupported assertion that this is incorrect and alleges that it is incumbent on Applicant to secure the provisional application to contest material or lack thereof with regards to priority status. Applicant respectfully traverses this assertion.

Applicant appreciates the Examiner's comments on this point during the telephonic interview. At that time, Applicant and Examiner continued to disagree as to on whom the burden of proof rests. Applicant respectfully opines that the statutes, case law, and MPEP indicate that the Patent Office bears the burden of proof.

Initially, Applicant notes that 35 U.S.C. § 102 indicates that "A person shall be entitled to a patent unless . . ." With this statutory language as the starting place, it is clear that the Patent Office bears the burden of proof in establishing that the reference contains the elements for which it is cited. Confirmation of the fact that the burden of proof in establishing obviousness or anticipation can be seen in cases such as *In re Fessman* 389 F.2d 742, (CCPA 1974) (holding implicitly that the Patent Office bears the burden of proof in making out a case of *prima facie*

obviousness in a product-by-process claim). See also MPEP § 2142, which indicates that the Examiner bears the burden of factually supporting any *prima facie* conclusion of obviousness. The Patent Office relies on the date of the provisional application without factually supporting the contents of the provisional application. This is improper. As MPEP § 706.02(f)(1) indicates, it is only appropriate to rely on the earlier filing date "assuming the earlier-filed application has proper support for the subject matter . . .".

Absent a showing by the Patent Office that factually supports the Patent Office's assertions, the Patent Office has not met its burden in factually supporting the allegation of *prima facie* obviousness.

If the Patent Office continues to maintain that it is Applicant's burden to provide the factual support, Applicant requests that the Patent Office provide a citation to an appropriate regulation, statute or case law that shifts the burden from the Patent Office to Applicant. Absent such a showing, the default rule is that the Patent Office bears the burden of proof.

Regardless, Applicant has secured a copy of the provisional application, reviewed it, and finds it deficient in every manner. As discussed in the telephonic interview, Applicant encloses a copy of the provisional application for the Examiner's convenience. The text of the provisional application only loosely corresponds to the text of the Jorgensen reference, blooming from an initial twenty-seven pages in the provisional application to the ninety that ultimately issued from the regular application. Furthermore, the drawings and elements referenced by the Patent Office are not present in the provisional application, and there is no reference to error reporting, captured IP packets, or the like as recited in Applicant's claims.

If, after its own review of the provisional application, the Patent Office disagrees with this statement, the Patent Office is requested to point out where in the provisional application support for the rejection can be found, preferably with an appropriate citation to page and line number. In the absence of such evidence, the rejection is not properly supported and the claims are allowable.

Applicant further appreciates the candor with which the Examiner addressed the breadth of claim 2, but on the record presently before Applicant, Applicant sees no need to amend the claims at this time. In light of the fact that the Patent Office has had four office actions and two advisory actions to come up with a better position, Applicant requests reconsideration of the rejection and claim allowance at the Examiner's earliest convenience.

Respectfully submitted,

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